

## REMARKS/ARGUMENTS

### Status

No claim has been cancelled by the proposed amendment. Claims 1-57, including independent claims 1, 29 and 45, will remain for further consideration.

### Claim History

The Examiner rejected claims 1-44 under 35 U.S.C. § 112, first paragraph, as being indefinite. The Examiner rejected claims 1-4, 6-16, 21-36, and 40-44 under 35 U.S.C. § 103 over Everingham in view of Walker. The Examiner rejected claim 5 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Bouchard. The Examiner rejected claims 17-20, 36-39 and 52 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Geiger et al.

### Claims Allowed

The indication by the Examiner in the recent Office Action that claims 45-57 are allowable over the prior art of record is noted with appreciation.

### Allowable Subject Matter, Otherwise Allowable Claims

The Examiner suggestion that claims 1-44 may be allowable if rewritten in independent form including all of the limitations of the base claim and of any intervening claims. Claims 1 and 29 have been substantially so rewritten. This proposed amendment is limited to those amendments.

35 U.S.C. § 112

The Examiner rejected claims 1-44 under 35 U.S.C. § 112, first paragraph, as being indefinite. The Examiner rejected claims 29-44 under 35 U.S.C. § 112, second paragraph, as being indefinite. The amendment of claim 29 should obviate the rejection of claims 29-44. The argument presented in the previous office action is stated below and is maintained herein. *Additionally, claims 1 and 29 now require that the document is unencrypted with the escrow encryption key and re-encrypted using the public encryption key and therefore it is clear that there is no need for the recipient to receive the escrow encryption key as the recipient's private encryption key is used to unlock the document. By this amendment and for the reasons below, this rejection should be withdrawn.*

As to claims 1-44, the Examiner objected as “unsupported” the recitation in claim 1 that “wherein an escrow unencryption key for unlocking said escrow encryption key is not made available to said recipient.” The Examiner pointed to the phrase in paragraph [0096] that the “escrow manager *could* transmit the escrow decryption key as part of the receiving system 300” (Emphasis Added) as allegedly meaning that it *must* transmit the key or that there is allegedly no other alternative explicitly provided and therefore the embodiment must prevail in interpreting the claims.

However, the Applicant respectfully submits that is not limited to claiming a particular preferred embodiment of the invention, and the fact that the invention “can be” operated in an alternate method, such as the escrow manage “can” transmit the escrow key, does not limit the claims to such an embodiment. One skilled in the art would recognize that encryption has very little value if the unlocking keys are provided to the

general public and are therefore the keys are not normally disclosed to others. In fact the name of the key generally tells one of ordinary skill in the art who is in possession of the public or private key, for example, a recipient's private key would be assessable only by the recipient and an escrow private key would be assessable only by the escrow agent. One skilled would also recognize that if a particular unlocking key "could" be provided to someone, then it would in general situations "not" provided to that person. Additionally, the next sentence in the quoted paragraph [0096] states that "alternatively, the OC 200 or escrow manager 211 could decrypt the document 3 and re-encrypt it with the recipient 300's public key prior to transmitting 555 it to the recipient 300." It is clear to one of ordinary skill in the art that the escrow key in this embodiment would not be transmitted to the recipient since escrow keys are by their very nature and definition confidential.

However, by the very fact that the disclosure was listed as an alternative (i.e., by the introductory word "could"), the element can by rule be excluded in the claims: "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff 'd mem.*, 738 F.2d 453 (Fed. Cir. 1984)" MPEP 2173.05(i) Additionally, even if the element was not listed in alternative, the general character of an encryption key would support its non-disclosure to the recipient as discussed above. See also MPEP 2173.05(i) ("A lack of literal basis in the specification for a negative limitation *may not* be sufficient to establish a *prima facie* case for lack of descriptive support." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)." Emphasis Added)) "The purpose

of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required 'to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.'" *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003). "Compliance with § 112 requires sufficient information in the specification to show that the inventor possessed the invention at the time of that original disclosure." *Pandrol*, 424 F.3d at 1165. In evaluating whether this requirement has been fulfilled, the application's "disclosure must allow one skilled in the art 'to visualize or recognize the identity' of the subject matter purportedly described." *Regents of Univ. of Cal. V. Eli Lilly & Co.*, 119 F.3d 1559, 1573 (Fed. Cir. 1997) "*Terms need not be used in haec verba, however...Instead, we have explained that the written description requirement can be satisfied by 'words, structures, figures, diagrams, formulas, etc.'*" *Kotto Manufacturing Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154 (Fed. Cir. 2005)(emphasis added) Therefore, there is ample evidence that the claims in supported by its present language in the specification as filed. For at least these reasons, the §112 rejection of claims 1-44 should be withdrawn.

### 35 U.S.C. § 103

The Examiner rejected claims 1-4, 6-16, 21-36, and 40-44 under 35 U.S.C. § 103 over Everingham in view of Walker. The Examiner rejected claim 5 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Bouchard. The Examiner rejected claims 17-20, 36-39 and 52 under 35 U.S.C. § 103 over Everingham in view of Walker and in further view of Geiger et al. This rejection is respectfully traversed.

Claims 1 and 29 as proposed to be amended now require encrypting the document with an escrow key when the recipient's public key is not available and re-encrypting the document with the recipient's public key prior to sending the document to the recipient. Nowhere is this shown or taught in the prior art. For at least this reason, claims 1 and 29 as amended and claims 2-28 and 30-44 respectively depending therefrom should be allowed over the prior art.

#### Amendment After Final

The amendments made herein are deemed necessary to properly respond to the outstanding Final Rejection and are intended to reduce the issues and present claims which are felt to clearly define the instant invention over the prior art. Care has been exercised to insure that no new matter has been introduced, nor have any new issues been raised. It is felt that no inordinate amount of time will be required on the part of the Examiner to review and consider this amendment.

#### Issues On Appeal

In the event that an appeal is filed, it is requested that this amendment be entered for purposes of appeal.

#### No further consideration or new matter

The proposed amendment does not raise any new issues that require further consideration and/or search and is a bona fide effort to satisfactorily conclude the prosecution of this application. Accordingly, it is respectfully requested that the proposed amendment be entered and that this application be favorably considered by the Examiner and passed to issue as expeditiously as possible.

## Summary

Applicants have made a diligent and bona fide effort to answer each and every ground for rejection or objection to the specification including the claims and to place the application in condition for final disposition. Reconsideration and further examination is respectfully requested, and for the foregoing reasons, Applicant respectfully submits that this application is in condition to be passed to issue and such action is earnestly solicited. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Robert N. Blackmon, Applicants' Attorney at 703-684-5633 to satisfactorily conclude the prosecution of this application.

No additional fees should be due with this amendment, however, authorization is granted to charge any additional or deficient fees or credit any overpayment for this filing to Deposit Account 50-0562.

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Respectfully submitted,

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